

REMARKS

Claims 1-19 are pending in this application. It is noted that the Office Action of January 15, 2003 incorrectly indicates on the cover page that only claim "5" is pending, when actually claims 1-7 had previously been pending before the addition of new claims 8-19. It is requested that the next communication from the Patent Examiner confirm all pending claims in this application.

Support for new claims 8-19 can be found on pages 6-8 of the present specification.

Traversal of Restriction Requirement and Request for "Rejoinder"

The Restriction Requirement of November 19, 2002 is respectfully traversed for essentially the same reasons stated in the previous Response filed December 2, 2002. It is submitted that the subject matter of all of the presently pending claims is sufficiently related such that no "serious burden" is placed on the Examiner to conduct prior art searches and examination for all of the claims of this application.

In addition to the above, it is further submitted that process claims 6, 7, 12, 13 and 16-19 should be "rejoined" under M.P.E.P. § 821.04 upon the indication of allowance of product claim 5 and claims depending therefrom.

Issues under 35 U.S.C. § 103(a)

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirukawa '095 (JP11-153095). This rejection is traversed for the following reasons.

Distinctions between Present Invention and Hirukawa '095

Hirukawa '095 is discussed at page 3 of the present specification. Hirukawa '095 discloses a golf ball on which the pattern is printed by a heat-transfer method. The ink of the transfer film contains a urethane resin having a hydroxyl value of 0 to 0.2 (exclusive) and at least either one of a polyester resin or an epoxy resin which has a hydroxyl value of 60 to 250.

Hirukawa '095 fails to disclose a molecular weight range of 20,000-60,000 for a polyurethane ink as in the golf ball of the present invention. Thus, this basis for the above-noted rejection fails to satisfy minimum requirements for alleging *prima facie* obviousness, since the disclosure or suggestion of the claimed invention must be found in the prior art. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991). Hirukawa '095 fails to disclose or suggest all the claimed features in the present claims such that no *prima facie* obviousness exists. In re Royka, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. Therefore, it is requested that the above-noted rejection be withdrawn.

The Office Action asserts at page 3 thereof that the molecular weight range of 20,000 - 60,000 "...would be obvious through routine experimentation to determine when the quality is best." Applicants respectfully reject this baseless and conclusory argument. First, this argument is prohibited because it relies on the disclosure of the present application for the suggestion to obtain the claimed range through routine experimentation. The Examiner is not allowed to rely on the disclosure of the application as noted in the Vaeck decision cited above. Second, there is no "routine experimentation" in obtaining the weight range of the present invention as evidenced by the description at page 7, lines 16-23 of the present specification. This description indicates that very specific and sophisticated synthetic techniques must be followed in order to obtain an appropriate molecular weight of the polyurethane in the ink. Specifically, the molecular weight must be manipulated by blocking terminal NCO groups with a monofunctional compound, such as a monoamine or a monoalcohol. These procedures are not disclosed in Hirukawa '095, or in any document relied upon by the Examiner. Consequently, it is submitted that the above-noted rejection must be withdrawn, since the basis of this rejection is lacking.

It is submitted for the reasons indicated above that all of the presently pending claims define patentable subject matter such

that this application should now be placed into condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


Andrew D. Meikle, #32,868

ADM/csm
0754-0155P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

5. (Amended) A golf ball comprising:

a golf ball body;

a pattern directly printed on a surface of the golf ball body with use of a transfer foil, the pattern being defined by an ink comprising a basic resin containing a polyurethane having a hydroxyl value of less than 0.2 and a weight-average molecular weight of 20,000 to 60,000, and a coloring agent; and

a clear coat formed over the pattern and the ball body surface.

Claims 8-19 have been added.